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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,987	03/11/2004	Roland Ramin	08048.0047-00	4626
22852	7590	03/13/2006	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			JACKSON, MONIQUE R	
			ART UNIT	PAPER NUMBER
			1773	

DATE MAILED: 03/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/796,987

Applicant(s)

RAMIN ET AL.

Examiner

Monique R. Jackson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-97 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-97 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/04 & 8/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 6-16, 25-34, 42-51, 61-70, 76-78, 85 and 87 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Though alternative expressions are permissive in the claims, they should be drafted in proper alternative format, i.e. “**selected from A, B or C**”; or in proper Markush claim format, i.e. “selected from the **group consisting of A, B and C**”. Considering the instant claims are not drafted in proper alternative format, it is unclear what is meant to be encompassed by the claims.

3. Claims 36-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 36 and 37 recite the limitation “wherein the wear resistance is greater than [10 and 15, respectively] % by weight, relative to the total weight of the composition.”

However, considering wear resistance was previously defined in parent claim 35, it is unclear whether this limitation refers to a different calculation method given the added term “relative to the total weight of the composition.”

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-18, 21-34, 86 and 93 are rejected under 35 U.S.C. 102(e) as being anticipated by Leacock et al (US 2003/0175255 A1.) Leacock et al teach a nail enamel or nail polish composition includes aluminum platelets and silicon dioxide particles, which silicon dioxide platelets are coated with a metal oxide to obtain an angle-dependent perceivable color shift in combination with a metallic or chrome-like background (Abstract.) Leacock et al also teach that the nail composition includes at least one organic solvent, at least one film forming substance, at least one plasticizer, at least one suspending agent, and at least one adhesion promoter; wherein disclosed suitable materials taught by Leacock et al read upon the instantly claimed texturizing agents and thickeners (Paragraph 0010, 0012, 0018, 0021.) The silicon dioxide platelet pigment is coated with one or more thin, transparent, or semitransparent reflecting layers of metal oxide, preferably titanium dioxide, tin oxide, ferric oxide or combinations thereof, is present in an amount ranging from about 0.5 to about 18wt% of the total composition, and has a particle size ranging from about 3 to about 60 microns (0010-0011, 0014.) The aluminum platelets are present in an amount ranging from about 0.03 to about 0.5 percent by weight of the total composition, and have a particle range from about 2 to about 26 microns (0011.) The composition may further include an additional color or pigment component or other cosmetically acceptable component selected from the group consisting of D&C colorants, FD&C colorants,

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inorganic pigments, organic pigments, mica, guanine, and mixtures thereof, wherein the amounts of any additional pigment component will depend on the shade desired and wherein pearls or micas having a particle size of less than 150 microns may also be included to further enhance the desired effect (0013, 0023.) Leacock et al teach that the film forming component, such as cellulose butyrate, polyurethanes, and mixtures thereof, is generally provided in an amount from about 5 to 40wt% of the total weight of the composition (0019.) Leacock et al teach that the nail composition is highly shelf stable and promote a superior and aesthetically pleasing nail enamel for natural human or synthetic nails (0025.) Leacock et al further teach that nail compositions in general are formulated to provide hardness, gloss, resistance to cracking, fading, chipping, peeling, and resistance to water soaps, cleaning solutions and lotions; and that the nail enamel compositions should last for an extended period of time (0007.) Hence, Leacock et al teach nail enamel formulations that read upon the instantly claimed components and ranges.

6. Claims 1-16, 21-34, 71-78, 88, 90-93, and 95-97 are rejected under 35 U.S.C. 102(b) as being anticipated by Ramin et al (USPN 6,296,839 B1, Ramin et al '839) teach a make-up nail varnish kit containing a first composition containing at least one film forming polymer and a second a composition comprising, in an organic solvent, at least one film-forming polymer, at least one metal pigment, at least one organopolysiloxane, and at least one pyrogenic silica; and a process for making up nails utilizing the nail varnish (Abstract.) The metal pigment has a mean particle size ranging from 5 to 150 microns, preferably 10 to 60 microns, and is present in an amount ranging from 0.1 to 25% by weight of the total composition (Col. 3, lines 52-67.) The metal pigment may be, for example, aluminum, copper, zinc, bronze, nickel powders, chromium powder, and equivalent powders (Col. 3, lines 45-49.) The film forming polymer may be chosen

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from radical polymers, polycondensates, and polymers of natural origin, and preferably comprises a mixture of 0.05 to 30wt% nitrocellulose and 0.05 to 30wt% cellulose ester of the base and/or surface compositions (Col. 4, lines 16-63.) The composition may also contain from 0.1 to 3% by weight of a clay, such as organo-modified bentonites, as well as additional agents provided in order to improve the film-forming properties of the composition, such as plasticizing agents, and commonly used additives including thickening agents, anti-foaming agents, dyes, additional pigments, surfactants, moisturizing agents, fragrances, neutralizing agents, stabilizing agents and antioxidants in suitable amounts (Col. 6, line 41-Col. 7, line 24.)

7. Claims 1-35, 38-71, 88-90, and 93-95 are rejected under 35 U.S.C. 102(a) or (e) as being anticipated by Ramin et al (USPN 6,491,932; Ramin et al '932.) Ramin et al '932 teach a cosmetic nail varnish composition comprising, in a cosmetically acceptable medium, a dyestuff comprising glass particles coated with at least one metallic coat, providing a sparkling and wear-resistant metallic appearance, wherein the glass particles can be combined with at least one colored pigment in order to obtain colored make-up with a metallic effect (Abstract, Col. 1, lines 62-65.) Ramin et al '932 teach that nails coated with the composition exhibit a mirror effect and also have good wear resistance, in particular, resistance to impacts, rubbing and abrasion, as well as good resistance to chipping (Col. 1, lines 50-65.) The glass particles coated with the at least one metallic coat, such as silver, aluminum, chromium, nickel, gold, and copper, are present in the composition in an amount ranging from 0.1 to 90wt% relative to the total weight of the composition, preferably 1 to 30%; and have an average particle size ranging from 1 micron to 500 micron, and a thickness generally ranging from 0.1 to 25 microns (hence having a shape factor within the instantly claimed range; Col. 2, lines 7-42.) The composition further comprises

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at least one film-forming polymer, including synthetic polymer, radical polymers, natural polymers, and polycondensates, in an amount ranging from 1 to 70% by weight of the total composition (Col. 2, lines 43-55; Col. 5, lines 6-9.) Ramin et al '932 also teach that to improve film-forming properties of the composition, in particular of the base and/or surface composition of the invention, at least one film-forming auxiliary agent may be provided, particularly plasticizers, and other additives may be incorporated including additional dyestuffs such as pigments, nacres, and flakes; thickeners, fillers, dispersants, antifoaming agents, stabilizers, antioxidants, and fragrances, in suitable amounts (Col. 5, lines 48-Col. 6, line 18.) Ramin et al '932 further teach specific examples that read upon the instantly claimed composition (Examples 1-5.).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 19-20, 35-85, 87-92 and 94-97 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leacock et al. The teachings of Leacock et al are discussed above. Though Leacock et al teach that the nail enamel composition provides good wear resistance, Leacock et al do not specifically teach the wear resistance of the coating as instantly claimed, however, one having ordinary skill in the art at the time of the invention would have been motivated to utilize routine experimentation to determine the optimum content of the components taught by Leacock et al to provide the desired wear resistance for a particular end use. In terms of the pigment

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particles, though Leacock et al teach that the particles are platelets having a preferred particle size, Leacock et al do not specifically teach the shape factor as instantly claimed. However, it is noted that platelets utilized in the art typically have a shape factor within the instantly claimed range and it would have been obvious to one having ordinary skill in the art to select a particular shape factor based on the desired aesthetic properties of the final coating. Further, though Leacock et al teach incorporating coated silicon oxide particles, contrary to some of the instant claims, Leacock et al clearly teach that these particles are provided for aesthetic purposes and hence one skilled in the art at the time of the invention would have been motivated to include or delete these coated silicone oxide particles based on the desired coloring and aesthetic properties of the final coating. With respect to the instantly claimed multicomponent kit with a second film-forming nail varnish composition, though Leacock et al do not specifically teach including the nail varnish composition with a second composition comprising a film-forming polymer as instantly claimed in a kit, it is well established in the art that nail color compositions as taught by Leacock et al, are commonly provided commercially with a second composition comprising a film-forming polymer as instantly claimed to serve as a base coat or top clear coat in making up nails and would have been obvious to one skilled in the art at the time of the invention.

10. Claims 17-20, 35-70, 80-87, 89 and 94 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ramin et al '839. The teachings of Ramin et al '839 are discussed above. Though Ramin et al '839 teach that the metal pigment may have a particle size that falls within the instantly claimed range, Ramin et al '839 do not specifically teach the shape of the particles as instantly claimed, however, flat or platelet metal pigments are conventional in the art and would have been obvious to one skilled in the art at the time of the invention, wherein one could

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determine the optimum shape factor to provide the desired aesthetic properties for a particular end use. Further, though Ramin et al '839 do not specifically limit the compositions to the instantly claimed ranges, one having ordinary skill in the art at the time would have been motivated to utilize routine experimentation to determine the optimum composition for each coating layer to provide the desired aesthetic and wear resistance properties for the finished colored nails for a particular end.

11. Claims 36, 37, 72-87, 91, 92, 96, and 97 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ramin et al '932. The teachings of Ramin et al '932 are discussed above. Though Ramin et al '932 teach an example having a weight loss greater than 5wt%, Ramin et al '932 do not specifically teach a weight loss of greater than 10wt% or 15wt% as instantly claimed, however, it is well established in the art that the components of the nail varnish composition as taught by Ramin et al '932 may be optimized utilizing routine experimentation to provide the desired wear resistance for a particular end use. With respect to the instantly claimed multicomponent kit with a second film-forming nail varnish composition, though Ramin et al '932 do not specifically teach including the nail varnish composition with a second composition comprising a film-forming polymer as instantly claimed in a kit, it is well established in the art that nail color compositions as taught by Ramin et al '932, are commonly provided commercially with a second composition comprising a film-forming polymer as instantly claimed to serve as a base coat or top clear coat in making up nails and would have been obvious to one skilled in the art at the time of the invention.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique R. Jackson whose telephone number is 571-272-1508.

The examiner can normally be reached on Mondays-Thursdays, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on 571-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Monique R. Jackson
Primary Examiner
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March 6, 2006